

REMARKS

Applicant thanks Examiner Willse for his courtesies to their undersigned attorney in an informal telephone conference on June 20, 2006. These remarks set forth the substance of what was discussed in the conference.

First, Examiner Willse and the undersigned discussed the nature of the objection to the specification. Examiner Willse explained that the faxed copy of the application in his file had many typed letters that were incomplete and thus difficult to decipher. The undersigned pointed out that since this application is the national stage of an international PCT application, the Examiner should have the record copy of the application from the International Bureau in the file that would not be a faxed copy. Examiner Willse indicated that he would check. The undersigned also pointed out that since he could not know which letters the Examiner might consider unclear, even from looking the copy of the application on PAIR as suggested by the Examiner,¹ it would not be possible to submit a marked-up copy of a substitute specification showing the changes made to overcome the problems in the faxed copy of record. The attached substitute specification includes all amendments made to the specification up to this time and does not contain any new matter.

Second, as discussed in the conference, applicant has amended claim 4 to correct the improper italicizing of the word “species” and to state that the claimed product or structure is intended for “medical or dental purposes,” as disclosed at page 10, lines 16-19, of the application as filed. Examiner Willse indicated that these amendments were helpful and that he would accept the change of “medical or related purposes” to “medical or dental purposes” to overcome a portion of the rejection of claims 4-13 under 35 USC 112, second paragraph.

¹ Actually, the specification of this application is not available even on Private PAIR, probably owing to its early filing date.

Claims 4-13 stand rejected under 35 USC 112, second paragraph, as being unclear allegedly for lacking a transitional phrase as prescribed by MPEP 2111.03. This rejection is respectfully traversed.

In the telephone conference, Examiner Willse stated his view that he was required by the MPEP to insist on the presence of a transitional phrase such as “comprising” or “consisting” in order to make the claim clear. The undersigned respectfully disagreed, presenting the example of a chemical compound claim that includes no transitional phrase. For example, it is obviously acceptable to claim “sodium chloride” as such instead of claiming it as “an ionic compound comprising sodium ions and chloride ions,” or some such words. In this case applicant is claiming a product of definite and stated characteristics, with sufficient clarity that the Examiner has seen fit to withdraw all of the prior art rejections of record. The issue as framed by MPEP 2111.03 is not an issue of claim clarity. That section says nothing about whether a transitional phrase is required for clarity and is instead directed to giving Examiners guidance on how to interpret various transitional phrases. MPEP 2111.03 is in the section of the MPEP entitled “Claim Interpretation; Broadest Reasonable Interpretation” and does not relate to rejections under 35 USC 112, second paragraph. The Examiner should instead refer to MPEP 2173.02, which states: .

The examiner’s focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

[Emphasis in original.] Applicant has prosecuted this case for many years without encountering the issue now presented by the Examiner, who even now is not saying in the Action that the claims are not susceptible of clear understanding. Since the MPEP citation underlying the rejection does not support the rejection, and another, more relevant, section of the MPEP suggests that applicant's claims are adequate in clarity, this rejection should be withdrawn.

In view of the foregoing, early action allowing claims 4-13 is solicited. If the Examiner still considers that the claims require amendment to be allowable, he is invited to telephone the undersigned to discuss such amendments.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. 229752001000.

Respectfully submitted,



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Dated: June 20, 2006

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